

### **REMARKS**

Pursuant to the final Office Action mailed April 8, 2011, claims 26-46, 48-80, 82-84, and 118-129 have been rejected, and claims 47 and 81 were objected to. In prior responses, claims 1-25 were canceled, and claims 85-117 and 130-157 were withdrawn, without prejudice to filing divisional or continuation applications. A Request for Continued Examination and fee are concurrently filed with this response. After entry of the present amendment, claims 26, 28-60, 62-84 and 118-129 remain pending in the application. The present amendment amends independent claims 26 and 122, amends dependent claims 27-48, 61, 84, and 129, and cancels claims 27 and 61, to clarify the scope of the claimed inventions of claims 26, 28-48, 84, 122, and 129. New independent claims 158 and 159 have also been added. No new matter has been added. Reconsideration of the application in view of the present amendment and following remarks is respectfully requested.

### **Summary of Examiner Interview**

Attorney for the Assignee wishes to thank Examiner Colbert for the telephone interview conducted on July 7, 2011. The claimed inventions and several distinctions over the cited references were discussed. No agreement as to patentability of the claims was reached.

### **Allowable Subject Matter**

Claims 47 and 81 were objected to as being dependent from a rejected base claim, but were indicated by the Office Action as allowable if rewritten in independent form including all elements of the base claim and any intervening claims. New claims 158 and 159 were added by the present amendments. New claim 158 incorporates the claim elements of claims 26, 32, 45, and 47. New claim 159 incorporates the claim elements of claims 58, 66, 79, and 81. Claims 158 and 159 are believed to be in condition for allowance, and a Notice of Allowance is respectfully requested for at least these claims.

### **Claim Objections**

Claims 27-48, 61, 84, 118, 119, 122, and 129 were objected to for certain informalities. Claims 27 and 61 are canceled by the present response. All of the suggested claim changes from

the Office Action have been incorporated in the present amendments, except those suggestions for claims 118 and 119, which are believed to already be in correct format without change. The claim objections are believed to be traversed.

#### Claim Rejections Under 35 U.S.C. § 112

Claims 26, 31, 34, 37, 38, 40-43, 45, 47, 50, 56, 58, 62, 65, 68, 71, 72, 74-79, 81, 82, 118, 119, 121-125, and 127 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 26-48 and 122 are amended by the present amendments to clarify the element of “a transaction account ....” The claim rejections are believed to be traversed.

#### Claim Rejections Under 35 U.S.C. § 103

Claims 26, 27, and 61 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,650,604 to Marcous et al. (hereinafter “*Marcous*”) in view of U.S. Patent No. 6,424,706 to Katz et al. (hereinafter “*Katz*”).

Claims 28-46, 62-80, 123, and 127-129 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marcous* in view of *Katz*, and further in view of U.S. Patent No. 5,457,305 to Akel et al. (hereinafter “*Akel*”).

Claims 48-58, 118, 122, and 126 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marcous* in view of U.S. Patent No. 6,012,048 to Gustin et al. (hereinafter “*Gustin*”).

Claims 59, 60, 119-121, 124, and 125 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marcous* in view of *Gustin*, and further in view of U.S. Patent No. 5,875,437 to Atkins et al. (hereinafter “*Atkins*”).

Independent claims 26, 48, 58, 118, and 122 have been amended by the present amendments. In particular, claim 26 has been amended to incorporate the subject matter of dependent claim 27. That is, claim 26 has been amended to include the element of “wherein the prepaid negotiable instrument is selected from the group comprising: a magnetic stripe card, a cash card, a check, a draft, a warrant, a money order, or a transit check” (underlining supplied).

Likewise, claim 58 has been amended to incorporate the subject matter of dependent claim 61, and claim 122 has been amended to incorporate subject matter similar to the subject matter of claims 27 and 61. These amendments are similar to the present amendment to claim 26. All of these amendments are fully supported by the Applicants' specification at least at pp. 8, and 13-15.

In all of the cited rejections of the Office Action, *Marcous* is cited as allegedly disclosing certain claim elements relating to either "a negotiable instrument" (in independent claims 58, and 122) or a "prepaid negotiable instrument" (in independent claims 26, 48, and 118). For example, the Office Action cites *Marcous* as allegedly teaching the claim 26 element of "a request for issuance of a prepaid negotiable instrument of a predetermined amount ... the prepaid negotiable instrument bearing identifying information associated with the individual ..." (underlining supplied). However, *Marcous* relates to a system and method for electronic transfer of funds using an ATM (*see* Abstract). While the Summary of the Invention in *Marcous* describes an object of the invention, "whereby cash, cash equivalent or other desired dispensed document (e.g., tickets, stamps, etc.) is issued directly to the designated recipient" (*see* col. 2, lines 33-44), the Specification of *Marcous* only describes how a sender initiates an electronic funds transfer to a recipient using an ATM to dispense only cash upon receipt of security information from the recipient (*see* col. 4, lines 16-30). There is no description in *Marcous* of how any "negotiable instrument" or "prepaid negotiable instrument" can be issued to a recipient by the system, process, or ATM machine described by *Marcous*. A "negotiable instrument" and "prepaid negotiable instrument" are very different from cash. A negotiable instrument can be defined as a guarantee of a fixed payment at a certain time, which is not cash or currency. Suitable negotiable instruments or prepaid negotiable instruments can be, but are not limited to, a magnetic stripe card, a cash card, a check, a draft, a warrant, a money order, and a transit check.

Furthermore, independent claim 26 includes the element of "the negotiable instrument bearing identifying information associated with the individual." Independent claims 58 and 122 have been amended to include a similar element of "the negotiable instrument ... bearing identifying information associated with the individual" (underlining supplied). *Marcous* does not teach or suggest this element since cash, currency, or anything else such as stamps or tickets,

that may be dispensed by the ATM in *Marcous* apparently lacks any identifying information associated with the individual.

Further, independent claim 26 includes the element of “whereby an individual bearing the prepaid negotiable instrument may obtain funds and/or instruct that payments be made of the directly deposited funds by presentation of the prepaid negotiable instrument to an agent associated with the licensed money transmitter computer system” (underlining supplied). Again, the difference between cash used in *Marcous* and prepaid negotiable instruments used by certain embodiments of the Applicants’ claimed inventions makes this element a novel feature over *Marcous*. If a user of the system, process, or ATM in *Marcous* has already obtained the electronically transferred cash from the ATM, there is no further reason for the user (recipient) to obtain funds or instruct payments be made of previously directly deposited funds. This element of claim 26 is missing from *Marcous*, and the lack of any teaching or suggestion of this element by *Marcous* shows a fundamental difference between the “cash issuing” invention of *Marcous* and certain embodiments of the Applicants’ claimed inventions.

Finally, none of the other cited references, including *Katz*, *Akel*, *Gustin*, or *Atkins*, teach or suggest the omitted claim elements described above. Thus, for at least the above reasons, the amended independent claims 26, 48, 58, 118, and 122 should be allowable over the cited references. Likewise, claims 28-46, 49-57, 59-80, 82-84, 119-121, and 123-129 are ultimately dependent from at least one of amended independent claims 26, 48, 58, 118, and 122, for which arguments of patentability are presented above. If the underlying independent claims are allowable over the cited references, the corresponding dependent claims should also be allowable.

**CONCLUSION**

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029. If the Examiner believes a telephone conversation would facilitate the examination of this application, the Examiner is invited to call the Attorney below at any time.

Respectfully submitted,

/Christopher J. Chan/

Christopher J. Chan  
Attorney for the Assignee  
Reg. No. 44,070

Date: **8 JULY 2011**

SUTHERLAND ASBILL & BRENNAN LLP  
999 Peachtree Street NE  
Atlanta, Georgia 30309-3996  
Telephone: (404) 853-8049  
Facsimile: (404) 853-8806

Attorney Docket No. **26466-0061US**